



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,792	03/30/2000	Vincenzo Scotto Di Carlo	GR 97 P 2659	7892

7590 02/27/2003

Lerner and Greenberg PA  
Post Office Box 2480  
Hollywood, FL 33022-2480

EXAMINER

PHAN, JOSEPH T

ART UNIT PAPER NUMBER

2645

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/538,792

Applicant(s)

DI CARLO ET AL.

Examiner

Joseph T Phan

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/30/00 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "call set-up" in claim 12 is a relative term which renders the claim indefinite. The term "call set-up" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-12 rejected under 35 U.S.C. 102(e) as being anticipated by Picard et al.,  
Patent No. 6,233,318.**

Regarding claim 1, Picard teaches a method of notifying a subscriber of a plurality of message services of a message: indicating, with each of a plurality of message services, to a common notification server a presence of a new message for a subscriber on the respective message service(col.3 lines 33-51) ; selecting, by the subscriber, at least one terminal from a plurality of terminals (col.3 lines 51-56, col.4 lines 4-14, and col.11 lines 16-27); and transmitting, with the notification server, to the least one terminal selected a notification indicating that a new message is present and in which message service the new message is present (col.2 lines 26-54 and col.11 lines 37-50).

Regarding claim 2, Picard teaches the method according to claim 1, which comprises, if a message service indicates the presence of a new message, storing with the notification server the data originating from the message service, until the respective notification has been transmitted successfully(col.11 lines 28-36 and lines 51-59).

Regarding claim 3, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to all terminals of the subscriber(col.11 lines 17-27 and 37-42).

Regarding claim 4, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting with the notification server the notification to at least one terminal selected by the subscriber from a plurality of terminals (col.4 lines 4-14 and col.11 lines 37-42).

Regarding claim 5, Picard teaches the method according to claim 4, wherein the

Art Unit: 2645

subscriber selects the terminal by transmitting a control information item from the respective terminal to the notification server (col.4 lines 4-14 and col.11 lines 17-27)

Regarding claim 6, Picard teaches the method according to claim 1, which comprises transmitting with each message service a message header information item to the notification server when a new message is present, and transmitting the message header information with the notification server at least partially to the at least one terminal selected, at least partially, to output the message header information (col.6 lines 35-62, col.7 lines 29-40 and col.19 lines 1-25).

Regarding claim 7, Picard teaches the method according to claim 1, which comprises, in response to a request by the notification server, transmitting with each message service a message header information item to the notification server, and transmitting at least partially the message header information item with the notification server to the at least one terminal selected to output the message header information(col.6 lines 35-62, col.7 lines 29-40 and col.19 lines 1-25).

Regarding claim 8, Picard teaches the method according to claim 1, which comprises, in response to a subscriber request from any terminal, firstly performing an authorization check with the notification server and then transmitting the notifications present to the terminal [col.4 lines 4-30, col.6 lines 35-62; subscriber is understood to have to log in(authorization check) to the notification server to access his/her messages].

Regarding claim 9, Picard teaches the method according to claim 1, which comprises processing with the notification server the data originating from the message services for generating the notifications transmitted to the subscriber(col.3 lines 38-62).

Regarding claim 10, Picard teaches the method according to claim 9, wherein the processing step comprises selecting one or more processes from the group consisting filtering, ordering, and formatting the data (col.3 lines 38-62 and col.11 lines 51-59; the data is formatted for the subscriber).

Regarding claim 11, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a signaling operation to the at least one terminal of the subscriber (col.11 lines 37-59; the notification alerts are signaling operations).

Regarding claim 12, Picard teaches the method according to claim 1, wherein the transmitting step comprises transmitting the notifications by means of a call set-up to the at least one terminal of the subscriber (col.4 lines 9-14 and col.11 lines 37-42; notification can be sent to telephones or cellular phones which is used for call set-up).

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is 703-305-3206. The examiner can normally be reached on M-TH 8:30-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

JTP  
February 23, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

